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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,015	02/08/2005	Tatsuji Enoki	1422-0662PUS1	7572
2292	7590	02/03/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			CLARK, AMY LYNN	
			ART UNIT	PAPER NUMBER
			1655	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/524,015

Applicant(s)

ENOKI ET AL.

Examiner

Amy L. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/08/05, 05/09/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 2 is objected to because of the following informalities: "*Petroselium sativum*" is misspelled. The correct spelling is "*Petroselinum sativum*". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of Claims 1-10 are rendered uncertain by the phrases "a disease accompanying an abnormality in an amount of insulin or insulin response" and "a processed product derived from a plant belonging to Umbelliferae". The phrase "a disease accompanying an abnormality in an amount of insulin or insulin response" is vague and indefinite because it is unclear as to what Applicant is referring. "A disease accompanying an abnormality in an amount of insulin or insulin response" could refer to any number of diseases and the phrasing is unclear. The term "a processed product" could be interpreted to mean an extract, a dried plant or a compound obtained by extraction from a plant belonging to Umbelliferae. The lack of clarity renders the claims

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indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

Claim 5 recites the limitation "the agent" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Maurel et al. (A).

Maurel teaches an organometallic complex having direct biocatalytic activity and capable of substituting for biocatalyst to modify certain pathological metabolic pathways (See column 4, lines 55-58) for the treatment and/or prevention of insulin and non-insulated related diabetes, insulin resistance and related pathologies (See abstract), which reads on a therapeutic/prophylactic agent for a disease accompanying an abnormality in an amount of insulin or insulin response and an insulin-mimetic agent. Maurel further teaches a metal for use in the organometallic complex is extracted from parsley (See column 6, lines 20-23 and column 11, lines 12-16), which is synonymous with *Petroselinum sativum*, which is a plant belonging to the Umbelliferae family.

Therefore, the reference anticipates the claimed subject matter.

Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Minegami (U).

Minegami teaches a health promoting beverage (See "Purpose"), which is considered to be a food, comprising of parsley juice (please note that parsley is synonymous with *Petroselinum sativum*, which is a plant belonging to the Umbelliferae family) for the treatment of the diseases of obesity and diabetes (See "Constitution" lines 1-4 and 6-10).

Therefore, the reference anticipates the claimed subject matter.

Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao (B).

Zhao teaches a coffee substitute and a non-caffeine beverage base produced from grain and legume (See column 1, lines 9-12) comprising of herbs and nuts (See column 2, lines 29-32), such as dehydrated parsley (See Column 6, Example 1) and walnut, which lowers blood lipids (See column 5, lines 58-60) and also comprising of arginine-phenylalanine-isoleucine-valine-serine-aspartic acid-leucine, which flatten the postprandrial glycemia response and improve glucose intolerance (See column 3, lines 1-8), to control weight and diabetes (See column 3, lines 21-25) and to prevent obesity (See column 2, lines 61-63), as high levels of glucose and lipids tend to turn into fat deposits (See column 9, lines 9-14), which reads on enhancement of glucose uptake and induction of adipocyte differentiation. Zhao does not expressly teach an agent, however, the ingredients in the coffee substitute, as taught by Zhao, have the same functional effect as the agent claimed by Applicant.

Therefore, the reference anticipates the claimed subject matter.

* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Amy L. Clark
AU 1655

Amy L. Clark
January 26, 2006


MICHELE FLOOD
PRIMARY EXAMINER